UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,423	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.739	5217

25883 7590 06/17/2004

HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER	
BROWN, RUEBEN M	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 06/17/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/382,423	Applicant(s) PHILYAW, ET AL	
	Examiner Reuben M. Brown	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-2 & 4-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/2004 has been entered.

Response to Arguments

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 6-7 & 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitsukawa, (U.S. Pat # 6,282,713).

Considering amended claim 1, the claimed method for delivering advertising to a consumer over a broadcast media/global communication network, comprising the steps of generating an advertisement broadcast comprised of a general program and associated advertising dispersed there through for broadcast over a broadcast media which is directed to a general class of consumers, reads on Kitsukawa which teaches that icons or objects that represent advertisements may be presented to a TV viewer during the display of a particular TV broadcast, (Abstract; col. 6, lines 40-53; col. 7, lines 25-35 & Fig. 5).

The claimed feature of embedding in the broadcast unique information for inducing a consumer to access a desired advertiser's location on the global network over a PC based system reads on Kitsukawa providing viewers with the advertisements that enable the viewer to connect with catalogs/web sites of manufacturers and dealers, (col. 8, lines 50-67). Also, the additionally claimed feature of broadcasting to the potential class of consumers, the advertisement broadcast with the embedded unique information therein, reads on transmitting the video broadcast along with the URL links which enables the users to access corresponding web pages or the links which enables connection to an electronic database.

Regarding the amended claimed feature of dispersing the unique information throughout the program broadcast at different places, such that the viewer is induced by at least a portion of

the received unique information to access the desired advertiser's location after a predetermined time in the broadcast and wherein the location of the unique information in the program broadcast is associated with the content of the program broadcast proximate in time thereto, Kitsukawa teaches that the advertising links may be associated with specific actors, actresses or by associating with icons that represents content; see col. 8, lines 51-67 thru col. 9, lines 1-10 & Fig. 5.

As for the information being at predetermined times, since Kitsukawa teaches that advertising data may be multiplexed with the program before it is broadcast, and the viewer is provided with an alert that informs the viewer that an advertising will be available, Abstract; col. 7, lines 10-20, the reference reads on the claimed subject matter..

Considering claim 2, the claimed method step of activating a network or server at the advertiser's location to wait for a response in the form of a network connection to the advertiser's location by a potential consumer, and upon a response from one of the consumers providing information additional to that contained within the advertisement broadcast, reads on the operation of Kitsukawa, wherein a user may select an advertisement that contains a web page or catalog link that connects the user to a manufacturer or dealer, col. 8, lines 51-60. Additional web pages are transmitted to the consumer, in response to requests for the instant web pages, by the well-known process of selection of icons, buttons, interactive images, etc.

Considering claims 6-7, the claimed feature of delivering a second portion of the advertisement at a later time is broad enough to read on Kitsukawa teaching that an

advertisement may be superimposed over a broadcast of a program, meaning over a segment of the TV broadcast. This includes a portion at a later time.

Considering claim 8, Kitsukawa discusses numerous methods for indicating that a selectable entity is available, including the use of audible tones, col. 7, lines 11-15 & col. 8, lines 27-31.

Considering claim 10, Kitsukawa discusses numerous methods for indicating that a selectable entity is available, including the use of audible tones, col. 7, lines 11-15 & col. 8, lines 27-31.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4-5, 9 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa, in view of Marsh, (U.S. Pat # 5,848,397).

Considering claims 4-5, Kitsukawa does not explicitly discuss embedding information in the advertisement that can be decoded by the PC and transferred back to the advertiser's location

upon access thereof by the consumer. Nevertheless, Marsh teaches at least embedding an identification code or number, for the purpose of tracking the number of times and by which consumers the instant commercial has been accessed; see col. 14, lines 20-23 & col. 14, lines 65-67 thru col. 15, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kitsukawa with the feature of embedding at least ID information in an advertisement, at least for the desirable benefit of tracking statistics data regarding the instant advertisement, as taught by Marsh.

Considering claims 9 & 11, Kitsukawa does not explicitly discuss embedding information in the advertisement that can be decoded by the PC and transferred back to the advertiser's location upon access thereof by the consumer. Nevertheless, Marsh teaches at least embedding an identification code or number, for the purpose of tracking the number of times and by which consumers the instant commercial has been accessed; see col. 14, lines 20-23 & col. 14, lines 65-67 thru col. 15, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kitsukawa with the feature of embedding at least ID information in an advertisement, at least for the desirable benefit of tracking statistics data regarding the instant advertisement, as taught by Marsh.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Voyticky Teaches storing advertising information while user is watching TV.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:
(703) 872-9314, (for formal communications intended for entry)
Or:
(703) 746-6861 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

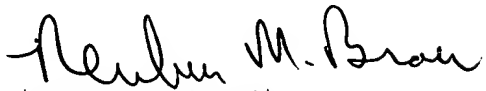
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399. The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9314 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown



REUBEN M. BROWN
PATENT EXAMINER